

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

REMARKS:

Claims 1-22 are all the claims pending in the present application and stand finally rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

CLAIM REJECTIONS.

35 U.S.C. §102

Claims 1-3, 6-8 and 10-15 are rejected under 35 U.S.C. §102(b) as being anticipated by. Applicant respectfully traverses this rejection for the following reasons.

Pantet discloses a conventional watch 1 and a suspension and support device 2 on which watch 1 is mounted in a removable manner. (Col. 3, ll. 22-25). Suspension and support device 2 (illustrated in detail in Figs. 3-5) includes a first part 11 and a second part 12. First part 11 is for removably holding the outer casing 3 of pocket watch 1. Second part 12 has the general shape of a substantially flat and rectangular ring and is connected to first part 11 via hinge 13. (Col. 3, ll. 38-66). Both parts 11 and 12 are configured so a conventional watch 1 may be suspended from a chain as well as enable the watch to be placed on a piece of furniture and so that the watch requires little space, for example when it is placed in a pocket of a garment. (Col. 4, ll. 7-10). Part 12 (rectangular ring) is shaped to form a suspension element allowing a snap hook 40 of a small suspension chain 41 to secure it. (Col. 4, ll. 11-14). Pantet discloses throughout that a main advantage/premise of its invention is to reduce the "bulky" nature of previous pocket and table watch configurations so that it is more convenient to carry in a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). Applicant lastly notes that Pantet, which discloses and claims only minor variations to many years of previous pocket watch configurations was issued as a patent in 1998.

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

Regarding Applicant's independent claims 1 and 6, the Office Action alleges that Pantet discloses Applicant's claimed *attachment section configured to be attachable to an object of interest*. Applicant respectfully disagrees. Pantet discloses only a rectangular ring 12 to which other articles (e.g., a hook 40 on a suspension chain) are configured to be attached. Ring 12 is not configured to be *attachable* to an object of interest.

As Pantet discusses only conventional pocket watches, Applicant further submits that Pantet does not disclose "*an electronic device*" as claimed in many of Applicant's claims (e.g., 6-8, 11, 13 or 15) (i.e., a pocket watch may be entirely mechanical). To this end, Applicant respectfully submits that the allegations on page 4, paragraphs g.-j. and page 5, paragraph l. of the 10/31/2005 Office Action are entirely unfounded and unsupported. Respectfully, even an unreasonably broad interpretation of Pantet cannot allege that Pantet discloses, mentions or remotely suggests a temperature sensor, MP3 player, multi-function display device, cell phone, PDA, calculator, digital camera, altimeter, compass or radio communication device as recited in Applicant's claims 10-11, 13 and 15.

Notwithstanding the foregoing, in an attempt to advance the prosecution of this application, Applicant amends independent claims 1 and 6 to more clearly define the attachment section as formed as a clip (similar to what is already recited in independent claim 16). Since Pantet element 12 is clearly not a clip or does not include a clip, there is no *prima facie* anticipation and reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103

Claims 1-22 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,781,512 to Pantet in view of some combination of previously cited references including U.S. Patent 5,540,367 to Kauker, U.S. 6,751,164 to Sekiguchi, U.S. 6,801,476 to Gilmour and/or U.S. 4,022,014 to Lowedenslager. Applicant respectfully traverses these rejections for the following reasons.

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/719,537

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In the instant rejections, the Office Action relies on Pantet to disclose the majority of Applicant's claim limitations with the exception of a *clip* (claims 1 and 16) or a carabiner clip (claims 4, 9). The Office Action relies on Kauker to make up for this notable deficiency alleging "[i]t would have been obvious to a person having ordinary skill in the art.... to modify Pantet to include a carabiner clip in the attachment section "because Kauker teaches that a carabiner clip is very functional and allows the watch to be attached to a wide variety of belongings such as backpacks, golf bags and any other attachable article...."

Applicant respectfully disagrees and submits that (I) there is no proper motivation for combining/modifying the references as suggested and (II) even when combining the references as proposed in the Office Action, the resulting combination still fails to teach or the limitations present Applicant's independent claims.

(I) NO PROPER MOTIVATION TO COMBINE/MODIFY REFERENCES

The Office Action alleges it would be obvious for the skilled artisan to modify Pantet with the carabiner clip of Kauker to allow a watch to be easily attached to a wide variety of objects. However, Pantet is devoted to a specific application for chain-based pocket watches and attaching pocket watches to a suspension chain 41 that already includes a "snap hook" 40. Accordingly, Pantet teaches away from the proposed motivation that "it to be easily attached to a wide variety of objects." Furthermore, Kauker explicitly teaches that the "pocket watch passed out of vogue in the early 20th century" and that other "practical and ornamental ways to mount

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

and carry watches" are needed other than chain pocket watches and wrist watches. (Col. 1, ll. 10-26).

Additionally, Applicant respectfully submits that the proposed modification of the Pantet pocket watch with the carabineer clip of Kauker (which is specifically designed as an alternative for traditional chained pocket watches and wrist watches) is expressly contrary to the teachings of Pantet because Pantet discloses that a primary goal of its invention is to reduce the "bulky" nature of previous prior art pocket and table watch configurations so that the resultant product can fit easily or conveniently into a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). To this end, Pantet shows, by virtue of Fig. 1 and 3 that its ring 12, should be relatively small and not cumbersome, while still be able to provide vertical support (table top configuration), to be manageable to carry around in one's pocket.

In contrast, Kauker teaches that chain mounted pocket watches are no longer used or desirable and proposes a new type of watch carrier 10. Referring to Figs. 1-9 of Kauker, watch carrier 10 includes an elongated hanger 14 which appears as large or larger than the watch 20 itself. Thus the proposed combination of Kauker hanger 14 with Pantet pocket watch 1 and casing 11 appears to be expressly contrary to the teachings of Pantet because such a modification would apparently double the weight/bulk of the resultant pocket watch. Further Pantet teaches that its suspension and support device 2 is specifically designed for attaching to a pocket watch chain 41 which already has its own clip 40. In contrast, Kauker discloses that "Ring 23 has been used in the past as the traditional place for attachment of gold or other precious metal chain when the watch was carried in the traditional manner in a gentlemen's vest. Employing this invention, the ring 23 is NOT used. (Col. 2, ll. 43-49; emphasis added). Consequently, the suggestion to form Pantet ring 12 as a clip (such as Kauker hanger 14) appears to be in direct contradiction to the express teachings of both references.

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

Lastly, the motivation for modifying the pocket watch of Pantet to include a carabineer clip is allegedly to enable a watch "to be easily attached to a wide variety of objects." However, Kauker already apparently teaches a watch hanging device 10, which includes a clip 14 that could "be easily attached to a wide variety of objects." Accordingly, there does not appear to be any motivation for the skilled artisan to redesign and reconstruct the device of Pantet to result in a watch that is easily attached to a wide variety of objects because Kauker already discloses such a device without need for redesigning the device disclosed by Pantet. Respectfully, the Office Action appears to conveniently select elements from the respective references when it suits the instant rejections while simultaneously entirely ignoring the context in which these elements are disclosed when it weighs against the proposed combination.

Because there is no objective reason for combining/modifying Pantet with Kauker as suggested in the Office Action, and in fact the cited references provide multiple reasons against the proposed motivation for making such a combination/modification, Applicant submits *prima facie* obviousness has not been established. Instead, it appears that the motivation to modify Pantet with the clip of Kauker is based solely in an attempt to reconstruct Applicant's claims in piecemeal fashion using the improper hindsight of Applicant's disclosure as a guide. Such hindsight is impermissible and does not establish *prima facie* obviousness.

(II) THE RESULTING COMBINATIONS FAIL TO TEACH OR SUGGEST ALL OF APPLICANT'S CLAIM LIMITATIONS.

Even assuming it would be proper to combine the teachings of Pantet with those of Kauker (*arguendo*), Applicant respectfully submits the resultant combination would still fail to teach or suggest several of the limitations present in Applicant's independent claims 1, 6 and 16 (and the remaining dependent claims at least by virtue of their dependencies). By way of example with respect to claim 16, Applicant submits that even the combination of Pantet and Kauker does not teach or suggest *a clip pivotally attached to the casing, the clip configured to be*

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

attachable to an object of interest, the clip configured to be pivoted to form a stand for the apparatus.

Kauker Figs. 1 and 2 show a watch 20 including a conventional crown 22 and a ring 23 (traditionally used for connecting to pocket watch chains but NOT used in Kauker's invention). A separate D-ring 21 is attached (via screws or brazing) to a side of watch 20 (or watch casing 20c) near the bottom or "6 o'clock position" of the case. (Col. 2, ll. 40-43). A hanger 14 is connected to watch D-ring 21 via a unitary double loop connector strap 15. (Col. 2, ll. 37-39).

The (strap) connector 15 is unitary and both ends are formed with loops or tubular-openings so that one end encircles an end 14a of hanger 14 and the other end encircles the D-ring 21 secured to the case 20c of watch 20.

Accordingly, even when combining the teachings of Pantet with Kauker, the most that the resulting combination could produce appears to be the suspension and support device 2 of Pantet suspended by hanger 14 Kauker via the strap connector 15. For example, the Kauker strap connector 15 would be attached to the Pantet cylindrical bar 28 and/or thicker adjacent portions 29 (Fig. 3) and the Kauker hanger 14 would be entirely separate (by the extension of the strap connector 15) from the Pantet suspension and support device 2.

Therefore, Pantet and Kauker, taken alone or in combination, fail to teach or suggest *a clip which forms a stand (or maintains a display device in a substantially upright position)* as recited in Applicant's independent claims 16 (or 1) or similar limitation which are present in Applicant's independent claim 6.

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/719,537

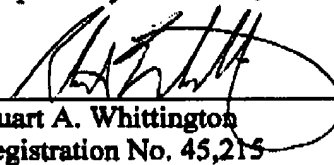
The remaining secondary references (e.g., Sekiguchi, Gilmour and/or Lowedenslager), without acquiescence as to the properness of their proposed respective combinations¹, also fail to make up for the deficiencies of Pantet and Kauker noted above. Since even the combination of all cited references of record fail to teach or suggest the clip or stand as recited in Applicant's independent claims, there is no *prima facie* obviousness with respect to any of Applicant's claims.

For all the foregoing reasons, Applicant respectfully submits all the pending claims are patentable over the cited art of record and requests reconsideration and withdrawal of all §103 rejections of record.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


Stuart A. Whittington
Registration No. 45,215
(480) 203-3235

7037 E. Monte Circle
Mesa AZ. 85209

Date: July 11, 2006

¹ Applicant does not address the specific merits of the rejections relying on the remaining secondary references because of the failings of the Pantet and Kauker combination (upon which all rejections are based) render addressing these references moot. Applicant reserves the right to dispute specifics of these rejections if later deemed necessary for purposes of Appeal.